REMARKS

This communication is filed in response to the *Office Action* having an electronic notification date of February 2, 2010. Claims 16 and 21 were amended to correct typographical errors. Claims 4 and 8 were previously canceled. No new claims are added. Consequently, claims 1-3, 5-7, and 9-22 remain pending in this application.

§ 101 Rejection of the Claims

Claims 1-3, 5-7, and 9-15 were rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. *Office Action*, page 4. Previously, Applicants amended claim 1, from which claims 2, 3, 5-7, and 9-15 depend, to recite, "determining, using one or more processors, a reliability indicator of at least one stored personal detail associated with the chargeable account." The Examiner maintained the rejection by asserting that '[c]laim 1 recites "using one or more processors', however this appears to simply be extra-solution activity." *Ibid*. Applicants maintain that the presence of one or more processors to perform an action effectively ties the claims to a particular machine. *See Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. §101* (August 25, 2009) at 15. Further, the *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. §101* (August 2009) states:

> Insignificant "extra-solution" activity means activity that is **not** central to the purpose of the method invented by the applicant. For example, gathering data to use in the method when all applications of the method would require some form of data gathering would not impose a meaningful limit on the claim. Page 6 (emphasis added).

The "one or more processors" of claim 1 are used to "determin[e] . . . a reliability indicator..." The "reliability indicator" of claim 1 is provided "to a user" upon making this determination. Because "determining . . . the reliability indicator" is the activity that is central to the purpose of the method of claim 1, it is not "extra solution" activity. As such, claim 1 includes at least one method step that is not "extra solution" activity that is tied to a machine (i.e., one or more processors) and is directed to statutory subject matter. Applicants request that the present rejection under 35 U.S.C. §101 be withdrawn.

§ 103 Rejection of the Claims

Claims 1-3, 5-7, 9, and 11-22 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,714,918 to Hillmer et al. (*Hillmer*). Since a *prima facie* case of obviousness has not been properly established, Applicants respectfully traverse the rejection.

In the *Office Action*, the Examiner incorrectly asserted that:

> Amended claim 1 recites "based on at least one of a time the at least one stored personal detail was received and associated with the account identifier". Examiner notes that all of the data disclosed by Hillmer are associated with account identifiers (6:37-65, 8:7-22), therefore in the broadest reasonable interpretation this amendment would not distinguish the claimed invention from the prior art. *Office Action*, page 2.

However, the Examiner is not considering all of the elements of amended claim 1. See, *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art."). As quoted by the Examiner, claim 1 recites "the reliability indicator determined based on at least one of *a time the at least one stored personal detail was received* and associated with the account identifier" (emphasis added). Because claim 1 is directed to "determining…a reliability indicator of at least one stored personal detail" and "providing [a] reliability indicator" and not "that all of the data … are associated with account identifiers," the Examiner is not properly considering all of the elements of claim 1.

The Examiner also asserted that:

> Moreover in Applicant's disclosure the only recitation that is enabled recites that the determination is performed by matching the stored personal detail to the candidate personal detail (page 8, "this comparison between candidate and stored personal details is carried out by seeking a literal match", page 12, "Optional Comparison Module 34 compares candidate and stored personal details to determine whether they match, as described above") and as Hillmer discloses matching (12:39-41), the data used in the matching process cannot be used to distinguish the claimed invention from the prior art as this is simply nonfunctional descriptive material as the same results would be achieved with Hillmer. *Office Action*, pages 2-3.

AMENDMENT AND RESPONSE UNDER 37 C.F.R. § 1.111
Serial Number:10/574,546
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Applicants challenge at least the assertion that "the only recitation that is enabled recites that the determination is performed by matching the stored personal detail to the candidate personal detail."

First, claim 1 does not include "matching the stored personal detail to the candidate personal detail." With respect to the "candidate personal detail" of claim 1, claim 1 recites "the at least one stored personal detail *usable to verify* at least one candidate personal detail" (emphasis added). As such, in the method of claim 1, the stored personal detail is *not* matched to the candidate personal detail, but used to verify the candidate personal detail. Further, because claim 1 is not directed to matching a stored personal detail to a candidate personal detail, the alleged support identified by the Examiner is irrelevant to the examination of the claims.

Moreover, the Examiner has provided no rationale for the argument that "data used in the matching process cannot be used to distinguish the claimed invention from the prior art as this is simply nonfunctional descriptive material as the same results would be achieved with Hillmer." *Office Action*, page 3. The Examiner also asserted that "as Hillmer discloses matching (12:39-41), the data used in the matching process cannot be used to distinguish the claimed invention from the prior art as this is simply non-functional descriptive material as the same results would be achieved with Hillmer." *Office Action*, page 6.

However, the same results are not achieved by *Hillmer* and claim 1 so the data used in the matching process is *not* "simply nonfunctional descriptive material." In *Hillmer*, the system *detects fraudulent transactions*. *Hillmer*, Abstract. More specifically, a "score is computed as a function of the authentication of the remaining parameters of the *transaction*" and is used to "determine the likelihood of a transaction being fraudulent." *Hillmer*, Abstract (emphasis added). The transaction parameters of *Hillmer* are associated with a number of "points" as shown in Table 1.0 (reproduced below):

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TABLE 1.0

TRANSACTION PARAMETER	POINTS
Positive Database match	−5.00
Negative Database (this vendor) match	+10.00
Negative Database (other vendor) match	+8.50
Not shipping to card holder address	+0.50
Shipping to card holder address	−1.00
Not shipping to customer address	+0.50
Shipping to customer address	−1.00
Shipping to Freight forwarder	+1.00

TABLE 1.0-continued

TRANSACTION PARAMETER	POINTS
Third party address verification (AVS) ok	−1.00
Third party address verification (AVS) partial ok	+2.50
Third party address verification (AVS) not ok	+5.00
Customer Svc. Rep. Suspects fraud	+5.00
High risk zip code	+1.50
Telephone order	+0.25
Total transaction amount	+0.50/$100
Air shipment	+0.50
Customer duration	−0.05/year
Customer status = excellent	−1.00
Customer status = good	−0.25
Customer status = fair	+0.25
Customer status = poor	+1.00
Credit card amount velocity exceeded	+0.50
Credit card count velocity exceeded	+0.50
Customer amount velocity exceeded	+0.25
Customer count velocity exceeded	+0.25
Ship-to-address amount velocity exceeded	+0.50
Ship-to-address count velocity exceeded	+0.50
Card Verification Value (CVV2) mismatch	+0.50
Card Verification Value (CVV2) match	−1.00

The transaction parameters of *Hillmer* quantify various aspects of the transaction itself and not the reliability of a stored personal detail. For example, whether the customer requests shipping to his own address versus to another address affects whether the transaction will ultimately be

considered fraudulent. In contrast, the "reliability indicator of . . . [a] stored personal detail" of claim 1 is

> based on . . . *a time* the at least one stored personal detail was received . . . , a record of *an identification procedure performed* upon receipt of the at least one stored personal detail, or a record of *a degree of personal exposure* of an entity submitting the at least one stored personal detail . . . (emphasis added).

The transaction parameters of *Hillmer* do not act as a reliability indicator of the "customer address" actually received from the customer that is submitted in the transaction but merely checks that the shipping address matches the customer address and assigns a point value based on the matching.

In support of the assertion that *Hillmer* teaches or suggests the "reliability indicator" of claim 1, the Examiner refers to the following paragraph of *Hillmer*:

> The consumer information provider 224 first computes *a fraud multiplier for the transaction* 100 (Block 306). The fraud multiplier is a score *based on the value of the transaction parameters* 116 *and whether the transaction parameters authenticate against databases* 308, 310, 312 of known information. These databases 308, 310, 312 include a customer information database 308, a negative account database 310 and a negative address database 312. Generally, these databases 308, 310, 312 contain specific customer and consumer information, statistical data and historical transaction data known to the participating vendors 106, 316, 318. Col. 7, lines 42-53.

Office Action, page 5. As such, the fraud multiplier of *Hillmer* is based on the transaction parameters (reproduced above). Because the transaction parameters are not

> determined based on at least one of a time the at least one stored personal detail was received and associated with the account identifier, a record of an identification procedure performed upon receipt of the at least one stored personal detail, or a record of a degree of personal exposure of an entity submitting the at least one stored personal detail,

the "fraud multiplier" of *Hillmer* does not teach or suggest the "reliability indicator" of claim 1. As such, Applicants assert that claim 1 is in condition for allowance and request the Examiner to reconsider and withdraw the rejection under 35 U.S.C. §103 with respect to claim 1.

Further, independent claim 16, as amended, has limitations similar to claim 1 and is asserted to also be allowable for at least the same reasons as those provided with respect to claim 1. Claims 2, 3, 5-7, 9, 11-15, and 17-22 depend either directly or indirectly from claim 1 or 16 and are allowable for at least the same reasons as their respective base claim. Further, these dependent claims may each be patentable for its own limitations.

Claim 10 was rejected under 35 U.S.C. § 103(a) as being allegedly obvious over *Hillmer* in view of U.S. Patent No. 6,070,141 to Houvener et al. (*Houvener*). However, *Houvener* fails to make up for any of the deficiencies not found *Hillmer*. Therefore, since claim 10 depends from claim 1, it too is allowable for at least the same reasons as claim 1. Further, claim 10 may be patentable for its own limitations.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4051 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this __2nd__ day of June, 2010.

___Chris Bartl_____   _/ C. BW /_____
Name   Signature